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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,166	09/14/2000	Thomas John Bitove	T8-465969CIP:DDH	9770

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EXAMINER

BARNIE, REXFORD N

ART UNIT

PAPER NUMBER

2643

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/662,166

Applicant(s)
Bitove et al.

Examiner
Rexford Barnie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 28, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10 and 15-37 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-10 is/are allowed.
- 6) ☒ Claim(s) 15-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

R. Barnie 07/25/02

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (US Pat.# 6,081,791) in view of Taskett (WO 96/38801, **cited by applicant**).

Regarding claim 1, Clark teaches a conventional ATM machine for purchasing prepaid telephone services and purchasing goods in addition to conventional ATM usage;

Clark teaches making available a plurality of distinct second pre-paid numbers for a plurality of pre-paid users. A user according to (see column 4 lines 40-column 5 line 33), a user can insert a debit or credit card into the ATM machine and a user can be prompt to select/choose

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as to the amount one would want credited to a pre-paid account to be used for subsequent calls.

In detail, Clark teaches an enhanced device for facilitating telephony access for providing good and services including telephone services by means of a prepaid account (see fig. 1) comprising:

one of a plurality of host computers (112, 114, 130, 170 of fig. 1) configured to generate card numbers (see column 4 lines 41-56, column 5 lines 20-28) with its inherent databases to store account information and a pre-paid calling card computer database (SCP, 160 of fig. 1, column 5 lines 38-55) adapted to store the card number information for a plurality of users wherein the information includes the original debit card number used or authorization information (see column 5 lines 24-26, lines 52-53) when a request is made for a pre-paid calling card account using a debit card;

a plurality of card forms (see column 6 lines 22-26) which according to Clark could be blank cards; and

a first remote terminal (ATM, 10 of fig. 1) configured to receive a request to purchase a card (see column 4 lines 66-67, column 5 lines 12-16) and to transmit information to the host computer (see column 5 lines 20-26) and receive information from the host computer (see column 5 lines 29-38) and having;

a first printer connected to slots (see 22 or 24 of fig. 1) for generating from the card forms cards having "purchase limit amounts" which *reads on an established prepaid account* (see column 5 lines 38-66), wherein the inherent printer imprints card numbers on the card forms (see

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column 6 lines 22-28) since Clark teaches that the cards can be initially stored in the point of sale terminal (ATM, 10 of fig. 1) as blank cards. Furthermore, the card could be imprinted with card numbers or account information either chosen by the user/requester, associated with the debit card used or automatically by a SCP (see column 5 lines 56-column 6 line 26) based on whichever information is designated in the SCP (see 160 of fig. 1) as account information. Clark teaches the possibility of having a plurality of ATMs disposed over a wide geographical areas which can be used in making pre-paid calls by means of telephone (28 of fig. 1) but fails to teach for the sake of argument that these ATMs does not require any extensive modification. Taskett teaches a methods and apparatus for providing a pre-paid remote entry customer account one can purchase a pre-paid account by means of checking/saving account, credit card and so forth (see page 8 lines 3-9). Furthermore, the ATMs could be conventional ATMs (see page 4 lines 16-20, page 6 lines 22-26). The prepaid accounts can be purchased to include values of \$5, \$20, \$100 or any desired amount (see page 5 lines 1-2).

Therefore, it would have been obvious to one of ordinary skill sin the art at the time the invention was made to include the teaching of Taskett into that of Taskett thus making it possible to provide a plurality of services (financial and communication) associated with ATM which for customers could be useful during emergency situations.

Regarding claims 16-22, The combination teaches being able to purchase a pre-paid account wherein a unique PIN makes it possible to make calls, debit the account (see Taskett or Clark), a printer as taught by Clark enables the ATM to print out a PIN number for the

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customer's telephone usage. The combination teaches a group of numbers assigned to a plurality of accounts in various denomination forms which includes accounts ranging from 5, 20, 100 or any desired amount as taught by Taskett (see page 5 lines 1-2).

3. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Taskett and further in view of McKoy et al. (US pat.# 5,621,787).

Regarding claim 23, the combination fails to teach the claimed subject matter but McKoy teaches a prepaid telephone system in (column 9) wherein a carrier can be selected to be associated with a prepaid account when a call is to be made selected from a plurality of IXC's.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of McKoy into that of the combination thus making it possible to make a call using a preferred carrier or a least cost carrier.

4. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (WO 96/38801, **cited by applicant**) in view of McKoy et al. (US pat.# 5,621,787).

Regarding claim 24, Taskett teaches a prepaid card system wherein a user can purchase a prepaid account with a desired amount in conjunction with a customer account such as a credit card, saving account and so on, recharge the account and to be able to use the prepaid account for making calls wherein the account is debited based on telephony usage (see page 1 lines 8-10, page 4 lines 16-20, page 5, page 7-page 8, page 10 lines 21-26) but fails to teach the ability of being able to select a desired service provider in conjunction with a prepaid account.

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McKoy et al. teaches a prepaid cash card wherein a bank account or credit card can be used in determining a subscriber's eligibility for a pre-paid account, a point of sale terminal can issue a subscriber a PIN number for telephone usage wherein the account would be debited based on telephony usage (see column 10, column 7 line 61-column 9 line 21). Mckoy teaches a prepaid telephone system in (column 9) wherein a carrier can be selected to be associated with a prepaid account when a call is to be made selected from a plurality of IXC's.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of McKoy into that of the combination thus making it possible to make a call using a preferred carrier or a least cost carrier.

Regarding claims 25-26, the combination including Taskett teaches the claimed subject matter in (see page 7-8).

5. Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (WO 96/38801, cited by applicant) in view of McKoy et al. (US pat.# 5,621,787) and further in view of Clark.

Regarding claims 27-30, The combination fails to teach the claimed subject matter in detail but Clark teaches a prepaid system wherein a user can charge prepaid account charges to another account and afterward be able to print. account identification information (see disclosure).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Clark into that of the combination thus making

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it possible to obtain a prepaid account without having use monies or deposit monies in a point of sale terminal.

6. Claims 31 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (WO 96/38801, cited by applicant) in view of Fougnyes et al.

Regarding claim 31, Taskett teaches a prepaid card system wherein a user can purchase a prepaid account with a desired amount in conjunction with a customer account such as a credit card, saving account and so on, recharge the account and to be able to use the prepaid account for making calls wherein the account is debited based on telephony usage (see page 1 lines 8-10, page 4 lines 16-20, page 5, page 7-page 8, page 10 lines 21-26) but fails to teach the ability of being able to associate a telephone number or ANI with a prepaid account.

Fougnyes teaches a security telecommunications system wherein the ANI associated with a wireless terminal could be used as means of triggering a pre-paid account when a call is made through a network (see column 3 line 37-column 4 line 34, column 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of ordinary skill in the art at the time the invention was made to incorporate the teaching of Fougnyes into that of Clark thus making it possible to make prepaid telephone calls without having to dial the account number but be able to do so based on simply the received ANI associated with the telephone which saves a user the time and effort to make the call.

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Regarding claims 36-37, The combination including Fournies teaches the claimed subject matter in addition to the fact that it's well known in the art to identify a mobile station based on a MIN and ESN.

7. Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (WO 96/38801, cited by applicant) in view of Fournies et al. and further in view of Clark

Regarding claims 32-35, The combination fails to teach the claimed subject matter in detail but Clark teaches a prepaid system wherein a user can charge prepaid account charges to another account and afterward be able to print. account identification information (see disclosure).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Clark into that of the combination thus making it possible to obtain a prepaid account without having use monies or deposit monies in a point of sale terminal.

Allowable Subject Matter

8. Claims 7-10 are allowed.

Response to Arguments

9. Applicant's arguments filed on 05/28/02 have been fully considered but they are not persuasive. .

The applicant argued that the prior art of record fails to teach a conventional ATM ie without any hardware additions to the device, hardware additions to the existing system or additional communication links to a telephone service provider.

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The examiner disagrees because the explanation as set forth in the rejection of the claimed subject matter is believed proper and permissible because the combination including Taskett teaches the possibility of being able to use a conventional ATM for the purpose of providing prepaid calling cards or PINs with if any software modifications.

Furthermore, the applicant has attacked the references individually when the explanation as set forth in the rejection of the claimed subject matter was based on the combination.

In summary, the explanation as set forth in the rejection of the claimed subject matter is believed to be proper and permissible.

CONCLUSION

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communication from the examiner should be directed to REXFORD BARNIE whose telephone number is (703) 306-2744. The examiner can normally be reached on Monday through Friday from 8:30 to 6:00p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708.

Any response to this action should be mailed to:

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or faxed to (703) 872-9314 and labeled accordingly (Please label **"PROPOSED/INFORMAL"** or **"FORMAL"**).

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 306-0377.

Rexford Barnie
Patent Examiner
RB 07/25/02

RVarnie